

### Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

### Substance of Interview

Applicants' attorney expresses his appreciation for the courtesy of a personal interview granted to him by Examiner Boykin on January 8, 2009, the results of which are summarized in the Interview Summary form given to Applicants' attorney at the conclusion of the interview.

Toward the beginning of the interview, Applicants' attorney proposed certain claim amendments. A copy of the claim amendments was kept by the Examiner. The amendments will be discussed below.

As Applicants' attorney discussed during the interview, the crux of the present invention resides in the discovery that the molecular weight and hydrolyzation rate constant can be controlled by features (A) and (B) as recited in claim 1.

The Examiner indicated that the amendments proposed during the interview will be entered, and appear to overcome all of the rejections under 35 U.S.C. §112, 35 U.S.C. §102(b) and 35 U.S.C. §103(a).

### Claim Amendments

Claim 1 has been amended exactly as discussed during the interview. That is, this claim has been amended to incorporate the features of claims 2 and 4, as a result of which claims 2 and 4 have been cancelled. Amended claim 1 further recites that the proton sources include free  $\alpha$ -hydroxycarboxylic acid and dimer thereof, which is based on the disclosure at page 10, lines 7 and 13 of the specification.

### Claim Rejections

The rejection of claims 1-14 under the first paragraph of 35 U.S.C. §112 is respectfully traversed.

As discussed during the interview, this rejection appears to be a new rejection which was not necessitated by Applicants' previous claim amendments, and therefore, the current Office Action should not have constituted a final rejection. The Examiner indicated during the interview that the present claim amendments would be entered even though they are being presented after a final rejection.

The Examiner refers to the disclosure at page 12, line 27 through page 13, line 1 of the specification that the total proton concentration of the impurities contained in the cyclic ester is preferably 0.01 to 0.5 mol%. Initially, Applicants point out that this is a **preferred** range. Furthermore, this range refers to the impurities in the starting cyclic ester without taking account of the amounts of the water and alcohol added to the polymerization system, now accounted for by the range of above 0.09 mol% and below 2.0 mol% of proton sources set forth in amended claim 1 above.

The rejection under 35 U.S.C. §112 also refers to the carboxyl group-capped agents. However, as noted during the interview, the capping agents employed in the present invention are not part of the inventive concept, which as noted above, resides in achieving the desired molecular weight and hydrolyzation rate constant by controlling features (A) and (B) recited in claim 1. Accordingly, Applicants respectfully submit that they should not be required to restrict the scope of the capping agents.

During the interview, the Examiner appeared to agree that the rejection under 35 U.S.C. §112 would be withdrawn.

The patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-11 under 35 U.S.C. §102(b) as being anticipated by EP 1 048 683, as well as the rejection of claims 1-6, 9-11 and 14 under 35 U.S.C. §102(b) as being anticipated by EP 0 299 730, are respectfully traversed.

As now clarified in amended claim 1 set forth above, the present invention is directed to a process for producing an aliphatic polyester of **a controlled molecular weight and a controlled**

**hydrolyzation rate constant** by ring-opening polymerization of a cyclic polyester containing **water and an alcohol which function** as initiators or/and molecular weight-adjusting agents. The present invention is based on the discovery that water and an alcohol both function as proton-source compounds, with the former being a carboxyl-source compound and the latter being an alkoxylycarbonyl-source compound; and by varying the total amount of proton-source compounds, i.e., carboxyl-source compounds (including water and proton-source impurities) and alkoxylycarbonyl-source compounds (including alcohol), and the ratio therebetween by varying the amounts of the water and alcohol in the cyclic ester, it becomes possible to provide an aliphatic polyester with a controlled molecular weight and a controlled hydrolyzation rate constant, as demonstrated in Figs. 1 and 2, respectively.

In short, the claimed process can be regarded as a method of controlling the molecular weight and hydrolyzation rate constant of the aliphatic polyester product by positively utilizing water and alcohol as molecular weight regulators and hydrolyzation regulators, which have not been contemplated in the conventional processes as disclosed in the cited references.

During the interview, the Examiner appeared to agree that the rejections for anticipation based on the EP '683 and EP '730 references would be withdrawn.

The rejection of claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over either EP '683 or EP '730 in view of USP 5,885,709 or USP 2,937,164 is respectfully traversed.

The comments set forth above concerning the EP '683 and EP '730 references are equally applicable to this rejection.

Claims 12 and 13 are both indirectly dependent on claim 1, which is the only independent claim. Claim 1 is patentable over the EP '683 and EP '730 references for the reasons set forth above. The US '709 and US '164 references are applied only for a teaching of carboxyl group-capping agents. But even if the references were combined, the result of such combination would still not suggest the subject matter of claims 12 and 13, considering that both of these claims are indirectly dependent on claim 1.

During the interview, the Examiner appeared to agree that the rejection under 35 U.S.C. §103(a) would be withdrawn.

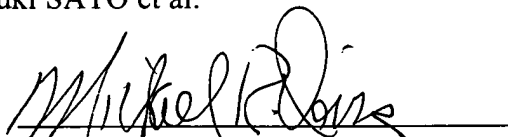
In response to the provisional obviousness-type double patenting rejection of claims 1-14 as being unpatentable over claims 1-12 of Serial No. 10/575,468, Applicants are submitting herewith a Terminal Disclaimer, which overcomes this rejection.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read "Michael R. Davis", is written over a horizontal line.

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